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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,460	07/18/2001	Lynn B. Lunsford	08191-014002	1198
26161 7590 06/02/2009 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
MARVICH, MARIA				
ART UNIT		PAPER NUMBER		
1633				
NOTIFICATION DATE		DELIVERY MODE		
06/02/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

09/909,460

**Applicant(s)**

LUNS福德 ET AL.

**Examiner**

MARIA B. MARVICH

**Art Unit**

1633

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 4, 52, 64-69, 85-113.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☒ Other: See Continuation Sheet.

/Maria B Marvich/  
Primary Examiner, Art Unit 1633

Continuation of 11. does NOT place the application in condition for allowance because: because applicants have not overcome the rejections under 35 USC 103 as set forth below. .

Continuation of 13. Other: Applicants have argued that priority for the instant application can be found in the priority document PCT/US98/01499. PCT/US98/01499 teaches microparticles for delivery of nucleic acids wherein the particles comprise a polymeric matrix, nucleic acid and a stabilizing compound. This stabilizing compound can be a lipid such as CTAB and furthermore interacts with the nucleic acids of the particles. Therefore, PCT/US98/01499 supports the teachings of the instant specification and the instant claims. Therefore, the instant claims are afforded the priority date of PCT/US98/01499, 1/22/1998. This means that the application predates the Lambert et al reference.

However, the rejection under 35 USC 103 as being unpatentable over Hedley et al (US Patent 5,783,567, effective filing date of 1/22/1997) in view of Balland et al (NATO ASI Series, 1996, Vol 260, pages 131-142) stands.

The claims were also rejected under 35 USC, 103 as being unpatentable over Paphadjopolous et al (US 6,210,707) in view of Cleek et al (J Biomed. Materials Res, 1997, pages 525-530). Paphadjopolous et al (US 6,210,707), was cited as art because it teaches lipidic microparticles made with amphiphilic cationic lipids complexed with nucleic acids and polymer (see e.g. col 7, line 16-29). Cleek teaches microparticles comprised of nucleic acid and PLGA, which appears to satisfy the limitation that the polymers have a solubility of less than about 1 mg/l. Paphadjopolous et al (US 6,210,707) is the US Patent of US serial number 09/076,618 filed 5/12/1998, which claims priority to parent application 08/967,791. A closer look found that 08/967,791 has been patented as 6,071,533 but was not retrieved in an art search because the term "microparticle" is not used. The question arises as to whether the compositions in both patents are inherently the same and hence both comprise "microparticles". Reviewing 6,210,707 reveals that the microparticle is a cationic lipid:nucleic acid complex wherein a lipid is complexed with a nucleic acid that is then combined with a polymer. The product is a condensed structurally stable complex with a size appropriate for transduction (see e.g. col 2, line 8-32). "The size of these lipid:nucleic acid complexes can be estimated by dynamic light scattering to be in the range of 410.+-.150 nm." These same teachings are found in 6,071,533. For example, "To keep the lipid:nucleic acid complexes from forming large aggregates and losing transfecting activity with time, two approaches are taken: (1) incorporating a small amount of a hydrophilic polymer such as PEG-PE (approx. 1% mole ratio) into lipid:nucleic acid complexes within a few minutes after their preparation; and/or (2) condensing the nucleic acid with a polycation such as a polyamine (e.g., approximately 0.05 to 5.0 nmole of spermidine per .mu.g DNA) prior to mixing with the liposomes. The optimal amount of the polyamines and hydrophilic polymer can be determined by one of skill in the art by titrating the polyamine or hydrophilic polymer with the nucleic acid so that the formed complexes do not form large, e.g., visible, aggregates. The size of these lipid:nucleic acid complexes can be estimated by dynamic light scattering to be in the range of 410.+-.150 nm.", which methods are also taught in 6,210,707. In fact, the same methods relied upon to in 6,210,707 for teaching formation of lipidic:nucleic acid complexes further complexed with polymers are found in both applications. The two differ in that it appears in that the 6,210,707 refers to these complexes as microparticles, however, they appear to be the same thing.